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No. 682

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

GEORGE SPECTOR, *Petitioner*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent*

On a Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

REPLY BRIEF FOR THE PETITIONER

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The petitioner herein, by his attorneys, respectfully submits this Reply Brief pursuant to Part 4, Rule 24 of the Rules of The Supreme Court of the United States and states this Honorable Court as follows:

1. Directing the attention of The Court to respondent's brief in opposition (Facts; p. 6), the respondent states, quoting in part from the transcript of a Patent Office Hearing, that (one of the petitioner's correspondence with a client) "... offered to 'provide any or all of the services that an inventor requires in protecting and promoting his invention:' (J.A. 7)". This statement, quoted in respondent's brief has omitted to include the fact that the quoted statement was qualified by, "... as indicated in my above letterhead." (J.A. 7) and that the letterhead to which reference was made was the letterhead of the petitioner, Spector, and that said letterhead referred to petitioner only as a licensed professional engineer and mentioned developmental work which work comes within recognized and legitimate engineering activities.

2. Further directing the attention of The Court to the brief of respondent (p. 11) and to respondent's contention that the petitioner's argument to the effect that Patent Office Rule 345 was vague and governed by insufficient standards and that this argument had not been presented below (Petitioner's Brief, pp. 12-13), petitioner states that on the contrary, this point was renewed by him at every stage of the proceedings:

(a) At the hearing held before the First Assistant Commissioner of Patents (J.A. 27), petitioner raised this point in a response to the Solicitor of the Patent Office as follows:

> "I make no attempt here to deny that I am doing work which is partly performed by patent attorneys and patent agents. There is no denial here. I think it is very clear that I am performing the services, but I do, my interpretation of that Rule 345 (d) is it? I do not know whether

it is "a" or "b" the words, "Patent Business" is used. If the words "Patent Business," if it was intended to define exactly what it was, why wasn't it defined in that Rule? In other words, why did they not itemize all the various things that Patent Business includes? That is so broad, that phrase "Patent Business" is so broad that it includes services legitimately performed by professional engineers."

(b) In the U.S. District Court for the District of Columbia, petitioning for review of the case in entirety, pursuant to 35 U.S.C. 32, petitioner again raised the question (J.A. 58-61).

(c) In the U.S. Court of Appeals for the District of Columbia Circuit, petitioner presented this question, and in his brief therein (p. 8) and argument, it was stated, "The corrollary proposition to this requirement of clear legal proof as unprofessional conduct *should be clearly defined and non-susceptible of varying construction.*" (Emphasis supplied.)

The petitioner submits that he has repeatedly urged this point to the Patent Office and to the Courts; that it is cogent, material and relevant, and as set forth in the language adopted by the court in *Parks* v. *Libbey-Owens-Ford Glass Co.*, 360 Ill. 130, 195 N.E. 616, (1935), "Statutes which either forbid or require doing of an act in terms so vague that men of common intelligence must necessarily guess at their meaning and differ as to their application transcend "due process of law".

The respondent, in his brief in opposition, (p. 11) cites *United States* v. *Tucker Truck Lines*, 344 U.S. 33, 37 (1952) in support of his conclusion that the petitioner may not properly raise the issue that Patent Office Rule 345 is governed by vague and insufficient

standards. Having reviewed the factual inaccuracies of respondent's position above, with respect to the holding of The Court in the *Tucker* case, petitioner submits that the decision in *Tucker* was a narrow and self-limited one and clearly distinguishable from the case at bar. In *Tucker*, as was pointed out by The Court, the sole question being considered was the validity of an objection to the improper appointment of an I.C.C. hearing examiner which objection was first made on petition for certiorari. The majority of The Court held that inasmuch as the examiner was a qualified one and that the hearing had been conducted in accordance with established rules and that no objection had been timely made the decision would stand. No similar circumstances attend the instant case nor do any applicable legal principles relate thereto. Petitioner submits that the doctrine of *Tucker* is applicable neither in fact nor governing principles of law and therefore supports none of the conclusions respondent seeks to draw therefrom.

3. Directing the attention of the Court to the argument of the respondent (p. 11, respondent's brief in opposition), respondent concludes that Patent Office Rule 345 is unassailable for two reasons. The first reason is that the Patent Office having been sustained on review by the U.S. District Court and affirmed by the U.S. Court of Appeals has maintained a firm proposition and secondly, the respondent argues that *Evans v. Watson*, 269 F. 2d 775 (D.C. Ct. App. 1959), *cert. den.* 361 U.S. 900, (1959) sustains this proposition. A review of *Evans* reveals that the action in that case was by way of injunction, it being sought to prohibit the Commissioner of Patents from the issuance of the regulation in question prohibiting advertising in a reversal of over 75 years of

prior practice. This was the entire issue for the consideration of the courts. It is readily apparent that the courts in *Evans* engaged in merely equating the regulation (Rule 345) to the regulations of various other Government agencies; no consideration was given as to the context of the regulations in the light of general patent practice or of any related services, e.g., engineering services as performed by petitioner in the instant case or as are performed on a continuing basis by many non-registered individuals and organizations. No consideration was given in *Evans* to any particular state of facts on their merits, or as to how the regulation was to be interpreted or applied. In the instant case, however, the reasonableness and definiteness of this particular regulation is under review for the first time and subject to an actual set of facts in a given situation. It is in the instant case that the issue of whether the Commissioner of Patents can regulate conduct which may be closely connected with the preparation of inventions for further patent effort (but which does not actually involve practice before the Commission) and, if the Commissioner of Patents can do so, whether Rule 345 is sufficiently definite and certain to accomplish the apparent objects without being violative of the requirements of due process. See, *Parks* v. *Libbey Owens Ford Glass Co., supra.* In order to follow and apply the argument advanced by the respondent, one is forced to first adopt respondent's conclusion that the application of Rule 345 in the instant case is a correct one because (a) the First Assistant Commissioner of Patents has so determined, and (b) the determination was sustained by the District Court and Court of Appeals, and then, to reason back to the premises. The *Evans* case held no more than that the Commissioner of Patents had proper statutory authority

to promulgate regulations in connection with practice before that agency. To proceed further under the circumstances and apply the argument of respondent to the holding in *Evans* defies the fundamental and accepted rules of logic and attributes more to *Evans* than is contained in the decision. The petitioner does not now and has never urged that the Commissioner lacked the power or authority to promulgate reasonable rules of practice before his agency; it is the petitioner's contention that, in the exercise of this rule-making authority that the Commission must comply with reasonable, objective standards of the actual conduct of patent practice and be sufficiently definite to permit their reasonable interpretation and application.

The respondent, in addition to ignoring the established working patterns of services ancillary to patent practice before the Commission, has herein equated these ancillary services, performed by the petitioner and others over a period of many years, to the regulation of the learned professions. Petitioner submits that an individual has a legitimate right to practice an engineering profession separately, which may concern itself with research, technical study and services, development and other related matters connected with inventions and to advertise these services, without being deprived of the privilege of that same individual to engage in a separate practice as a licensed patent agent.

4. In respondent's brief in opposition, in a footnote (2) beginning on page 11, respondent now advances a view that there is no substantive difference between *suspension* from practice and *exclusion* and concludes that there is none. Title 35 U.S.C. Section 32, is entitled SUSPENSION OR EXCLUSION FROM PRAC-

tice. All of the language used in this section states *suspension* or *exclusion* as alternatives. It would appear to be a wholly unwarranted assumption, whatever rules of construction or interpretation be applied to this language that it was intended that they be read as being synonymous. In Webster's Collegiate Dictionary (5th Edition) it is stated that *exclude* means "to hinder from entrance, to refuse participation, enjoyment, consideration or inclusion, to eject; expel. Webster further states that it is synonymous that to *exclude*, as here compared, is to keep out what is already outside. Webster defines the word *suspend* as meaning, "to debar temporarily from any privilege, office, function, etc.; as to *suspend* a student. "Black's Law Dictionary (3rd Edition) defines *suspend* as, "to interrupt; to cause to cease for retirement; to stay, delay, or hinder; to discontinue temporarily but with an expectation or purpose of resumption. To forbid a public officer, attorney, employee, or ecclesiastical person from performing his duties or exercising his functions for a more or less definite interval of time." It seems that in common, as well as legal usage, there is an accepted difference and distinction between the term *exclude* and the term *suspend*. It further is urged by petitioner that it is implicit in the application of *suspend* that upon the expiration of the period of "temporary duration" there is an automatic reinstatement of function but that the common acceptance of the term *exclude* does not anticipate this occurrence and more generally appears to mean the "keeping out of that which is already outside."

The record in the instant case, considered by the tribunals below, includes (at every consideration) the decision of the First Assistant Commissioner of Pat-

ents and his subsequent inconsistent Order and reference to these was made at each stage for the purpose of having these tribunals give their consideration. "Record" within the definition of "plain or fundamental error" as "error apparent on the face of the record" includes pleadings, verdict and judgment." *Clymont* v. *First Nat. Bank*, 115 Tex. 342, 282 S.W. 558, (1926).

Petitioner submits that this matter is one which the courts below could and should have corrected in the course of their review. "Where error is manifest on the face of the record it is the duty of the Court to correct it, and it may do so on its own motion." *Duke* v. *Campbell*, 233 N.C. 262, 63 S.E. 2d 555, (1951). In considering appellate review generally, the Missouri Court stated: "(The) Appellate Court must examine transcript on appeal with respect to the presence of error of such character as (the) Court is entitled to consider and if error was committed materially affecting the merits of the action, (the) Appellate Court must give such judgment as the Trial Court should have given." *Tilson* v. *Terminal R. Ass'n. of St. Louis*, 236 S.W. 2d 42 (St. Louis Ct. App. 1951) [no official citation]. It would be difficult to imagine an instance in which an error apparent on the face of the record is more clearly illustrated than in the instance case where an order based on a previous decision is so obviously inconsistent therewith. In *Suydam* v. *Williamson*, 61 U.S. 427, 20 How. 427, 15 L. Ed. 978 (1858), this Court observed, "Wherever an error is apparent on the face of the record, it is open to revision, whether it be made to appear by a bill of exceptions or, in any other manner." Further, in *Suydam*, The Court went on to say, ". . . . any error apparent in any part of record is within the revisory power of such tribunal."

CONCLUSION

For the foregoing reasons and for those hereinbefore set forth in the Petition for Certiorari heretofore filed, petitioner respectfully submits that this petition should be granted.

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